

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:)
Thomas W. POPLAWSKI *et al.*) Group Art Unit: 3624
Application No.: 09/772,601) Confirmation No.: 1711
Filed: January 30, 2001) Examiner: Daniel S. FELTEN
For: ELECTRONIC BILL)
PRESENTMENT AND PAYMENT)
SYSTEM AND METHOD)

Mail Stop ***Appeal Brief - Patents***
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

REPLY BRIEF

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Sir:

In accordance with 37 C.F.R. § 41.41(a)(1), Appellants hereby file this Reply Brief ("Reply Brief") in response to the Examiner's Answer filed on June 20, 2006. The requisite fee in accordance with 37 C.F.R. § 41.20(b)(2) is enclosed. It is respectfully submitted that this Reply Brief is timely within two months of the Examiner's Answer. Appellants believe that no additional fees are deemed necessary, however if there are any deficiencies, please charge the undersigned's Deposit Account No. 50-0206.

It is respectfully submitted that (1) the Examiner is relying on an erroneous legal standard in his obviousness rejection and (2) the Examiner has failed to establish a *prima facie* case of obviousness. Therefore, Appellants respectfully request that the Board of Patent Appeals and Interferences reconsider and withdraw the rejection of record, and allow the pending claims.

I. SUMMARY OF ARGUMENTS IN VIEW OF EXAMINER'S ANSWER

The Examiner's Answer has been received and carefully considered. The Examiner is maintaining the obviousness rejection of claims 1-3, 6-9, 17-19, 24-26 and 29-32 based on Haseltine (U.S. 6,578,015) and Hogan (U.S. 5,699,528). The Examiner is also maintaining the obviousness rejection of claims 4, 5, 10-16, 20-23, 27 and 28 based on Haseltine, Hogan, Schutzer (U.S. 6,292,789) and Hilt (U.S. 5,465,206). In addition, the Examiner has responded to some of Appellants' arguments presented in the Appeal Brief.

These responses reveal that the Examiner has relied on an erroneous legal standard and misinterpreted the cited references in maintaining the obviousness rejections. As a result, the Examiner has (1) failed to prove the disclosure of all the claim elements in the prior art, (2) failed to consider the claimed invention as a whole, and (3) failed to provide a plausible motivation to combine or modify the cited references.

II. *IN RE BOZEK* DOES NOT RELIEVE EXAMINER'S BURDEN OF PROVING ACTUAL DISCLOSURE OF ALL CLAIM ELEMENTS IN THE CITED REFERENCES.

The Examiner begins the Response to Argument section by stating: "References are evaluated by what they suggest to one versed in the art, rather than their specific disclosure (see *In re Bozek*, 163 USPQ 545 (CCPA 1969))." Examiner's Answer at 11. The Examiner also asserts that "applicant has applied a more stringent standard to the reference than the limitations of the claims ... as the reference is used as a whole as a teaching in light of the level of skill in the art." *Id* (emphasis added). Since it is unclear which part of the Appeal Brief the Examiner refers to, Appellants will treat these statements as a general response to Appellants' non-obviousness position.

The Examiner appears to believe that, by treating the cited references "as a whole," he does not have to point out which portions of the references actually teach or suggest all the

elements of the claimed invention. The Examiner also appears to accuse Appellants of ignoring certain disclosures of the cited references. Appellants respectfully disagree and would like to take this opportunity to clarify the proper legal standard for an obviousness rejection.

As stated in MPEP § 2143.03, to establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. In re Royka, 490 F.2d 981, 985 (CCPA 1974). If no combination of the prior art, even if supported by a motivation to combine, would disclose all the limitations of the claims, no obviousness is established. CFMT, Inc. v. Yieldup Int'l Corp., 349 F.3d 1333, 1342 (Fed. Cir. 2003). In other words, the Examiner bears an initial burden of proving that each and every claim element can be found in specific disclosures of the cited references. Such disclosures may be explicit or implicit, but disclosures there must be.

The Examiner, however, erroneously relies on the In re Bozek decision as relieving him of this initial burden. The Examiner's understanding (or misunderstanding) of that decision is somewhat reflected in how he restates it —

“References are evaluated by what they suggest to one versed in the art, rather than their specific disclosure.”

Examiner's Answer at 11 (emphasis added). The original quote reads a little different —

“a reference disclosure must be evaluated for all that it fairly suggests and not only for what is indicated as preferred.”

In re Bozek, 163 USPQ at 549 (emphasis added). The Bozek court was actually citing In re Boe, 355 F.2d 961 (CCPA 1966), which stated:

“All of the disclosures in a reference must be evaluated for what they fairly teach one of ordinary skill in the art.”

Id at 965. In other words, In re Bozek recognizes that everything found in a reference may qualify as prior art and its disclosure is not limited to any preferred embodiment described

therein. It does not stand for the proposition that, under the guise of treating a reference “as a whole,” the Examiner can avoid identifying specific disclosures of the reference that teach or suggest the claim elements under rejection. Nor does it authorize the Examiner to use hand-waving remarks to gloss over the differences between the claimed invention and prior art references.

Appellants were not applying “a more stringent standard to the reference than the limitations of the claims” when Appellants insist that all the claim limitations be found in the cited references. The whole point of an obviousness rejection is that all elements of the rejected claim can be found in the prior art *and* it is obvious for one skilled in the art to combine these elements. Therefore, Appellants are entitled to a threshold showing that, for each and every claim element, there exists some specific disclosure in the prior art that either teaches or suggests the same. This requirement cannot be substituted with general remarks about the references “as a whole” or be subsumed into the next step of showing a motivation to combine.

Appellants pointed out, in the Appeal Brief, that none of the references teach or suggest “at least one portion of the electronic summary being formatted in the form of a remittance slip” or “printable to serve as a remittance slip in a traditional method of payment” as recited in claim 1. The Examiner has not produced any persuasive evidence or argument that any of the cited references even contemplates these claim elements. If none of the references ever mentions the step of formatting bill data in the form of a remittance slip, Appellants fail to understand how this missing element can be miraculously discovered when the references are combined or treated “as a whole.” Logically, the Examiner must have identified relevant and sufficient prior disclosures before he can combine them to render the claimed invention. If the Examiner only

has an incomplete set of elements, whatever combination made out of those elements will be different from the invention in question.

Although the Examiner claims to consider the cited references “as a whole,” his actual treatment of the references speaks otherwise. Treating a reference “as a whole” means considering all the specific disclosures found therein. As stated in MPEP § 2141.02, “a prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention.” W.L. Gore & Associates, Inc. v. Garlock, Inc., 721 F.2d 1540, 1550 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984). The Examiner’s way of treating the references goes against this guideline. The discussion of the phrase “remittance slip” is exemplary. While Appellants have quoted several passages from the cited references that clearly teach away from the traditional bill payment method (Appeal Brief at 14-15), the Examiner chooses to ignore them. Instead, the Examiner chooses to argue the inherent nature of a bill as including a remittance slip. Examiner’s Answer at 12-13. Such an argument is disingenuous as it takes the prior art disclosure of a paper remittance slip out of its context. In the context of the cited references, the traditional payment method involving paper bills and checks is exactly what Haseltine and Hogan strive to avoid. For example, Haseltine finds such a payment process “lengthy and costly” (col. 1, lines 55-57), and Hogan criticizes it as “labor intensive and time consuming for a bill-payer” and entailing “significant costs to the payees who receive and handle remittances in this manner” (col. 2, lines 60-62). However, the Examiner does not seem to give any weight at all to such express criticism of traditional payment method involving remittance slips.

For the foregoing reasons, the Examiner has misinterpreted case law and failed to show that all the claim elements are disclosed in the cited references.

III. BY FOCUSING ON AND OVERSIMPLIFYING THE DIFFERENCES BETWEEN THE CLAIMED INVENTION AND PRIOR ART, THE EXAMINER FAILS TO CONSIDER THE CLAIMED INVENTION “AS A WHOLE.”

While the Examiner finds it convenient to treat the cited references “as a whole,” he does not seem to give the same treatment to the claimed invention. As stated in MPEP § 2141.02, in determining the differences between the prior art and the claims, the question under 35 U.S.C. §103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious. Stratoflex, Inc. v. Aeroquip Corp., 713 F.2d 1530, 1537 (Fed. Cir. 1983). Further, “all words in a claim must be considered in judging the patentability of that claim against the prior art.” In re Wilson, 424 F.2d 1382, 1385 (CCPA 1970). It is respectfully submitted that the Examiner has not met these requirements.

The Examiner has impermissibly oversimplified the differences between the claimed invention and the cited references. An important distinction is that the claimed invention teaches formatting a portion of bill data in the form of a remittance slip and providing such an electronic remittance slip (printable) to a customer so that he or she can choose between electronic and paper-based payments. The Examiner, however, chooses to recognize the printable feature of an electronic summary as the only difference between the claimed invention and Haseltine (Examiner’s Answer at 4), completely ignoring the fact that Haseltine also fails to teach or suggest formatting a remittance slip and providing the electronic remittance slip to a customer. For the printable feature, Hogan is cited (Abstract and col. 5, ll. 1-15) despite the fact that Hogan only mentions printing a bill, not printing a remittance slip or using a printed bill as a remittance slip. If the printability of an electronic bill were the only difference, the Examiner should not have to cite Hogan at all as Haseltine itself already discloses printing out paper bills (col. 1, line 20).

Related to the printable feature are the steps of formatting a remittance slip and providing the electronic remittance slip to a customer. None of the references even contemplate generating an electronic remittance slip because they all view the traditional paper-based payment method as undesirable. However, consistent with his disregard of the prior art teachings that lead away from the provision of an electronic remittance slip, the Examiner ignores the corresponding limitations in the pending claims. Therefore, the Examiner has managed to distill the claimed invention to nothing more than a generic electronic bill presentment and payment (EBPP) system (with an insignificant feature that the bills can be printed out). Then, based on this insignificant difference between the oversimplified invention and the prior art, the Examiner rejects the pending claims as obvious. The obviousness conclusion reached through such a process cannot be legally upheld.

IV. THE EXAMINER FAILS TO PROVIDE A PLAUSIBLE MOTIVATION FOR COMBINING OR MODIFYING THE CITED REFERENCES.

The Examiner asserts that an artisan of ordinary skill in the art would be motivated to combine Haseltine with Hogan in order to “have an alternative to viewing the bills [online]” and to “feel more secure with using an online billing/payment system.” Examiner’s Answer at 4. Alternatively, the motivation may be to use “printed copies [of billing information] as backup of their electronic files in the event that the electronic files and/or database becomes corrupted, compromised and/or lost.” *Id.* Such motivations might explain why it is desirable to make a bill printable, but they do not justify the formatting and provision of an electronic remittance slip.

While a printable bill only facilitates alternative viewing and file backup, a printable remittance slip affords a choice between electronic and paper-based payments as recited in independent claims 1, 19 and 24. Although the Examiner’s articulated motivation to combine references does not have to be identical or similar to an inventor’s own, the former must lead to

the same invention as inspired by the latter. Here, the motivations suggested by the Examiner will not cause electronic remittance slips to be formatted and provided to banking customers because the electronic remittance slips are unnecessary for offline viewing or paper backup of the bills. Including the additional data of electronic remittance slips in the electronic bill presentation will only slow down the downloading and printing of other billing data. The provision of electronic remittance slips may also cause some confused customers to mail in checks for their payments, exactly the scenario which the Haseltine and Hogan paperless systems were designed to avoid.

The Examiner attempts to show that Haseltine has “inherently” disclosed an electronic remittance slip. “The examiner interprets the ‘look’ of a traditional paper bill to inherently include a form of remittance information. Thus the examiner argues that Haseltine suggests a [sic] electronic remittance slip, being inherently conjoined data to the electronic bill.”

Examiner’s Answer at 13. The Examiner is mainly relying on the following statement in Haseltine:

“The bill format data 404 may include HTML-formatted data configured to mimic the “look-and-feel” of the biller’s traditional paper bills, when rendered on a display device.”

Haseltine, col. 5, ll. 15-19 (emphasis added). The Examiner’s interpretation is wrong because it is out of context. Within the above-quoted sentence, the “look-and-feel” of the paper bills refers to the on-screen appearance of bill data. It does not teach making the bill data printable like traditional paper bills. Nor does it teach or suggest formatting a remittance slip or making it printable. Within the bigger context of the Haseltine disclosure, the “look-and-feel” of the electronic bills is offered for the purpose of preserving the billers’ corporate identity (col. 2, ll. 60-62). It is difficult to image how the provision of unnecessary electronic remittance slips can serve the purpose of preserving corporate identity. It is also difficult to imagine why Haseltine

would intend the “look-and-feel” of the electronic bills to include remittance slips when he is trying to avoid “the disadvantages associated with … paper bills and checks” (col. 2, ll. 26-30).

A fair reading of Haseltine and other cited references makes it clear that the very idea of an electronic remittance slip is at odds with the basic teachings of these disclosures. There is simply no motivation, suggestion or teaching to combine the cited references.

V. CONCLUSION

For the foregoing reasons, Appellants respectfully submit that the cited references fail to render Appellants' claims 1-32 obvious under 35 U.S.C. § 103(a). Accordingly, Appellants respectfully request reversal of the final rejection of claims 1-32.

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Respectfully submitted,

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